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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,239	12/21/2001	James N. Humenik	FIS920010261US1	4441

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EXAMINER	
MARKOFF, ALEXANDER	

ART UNIT	PAPER NUMBER
1746	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,239	HUMENIK ET AL.	
	Examiner	Art Unit	
	Alexander Markoff	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,280,527 in view of Spring (Metal Cleaning).

The claims US Patent No 6,280,527 disclose cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures.

The Patent does not teach electrolytic cleaning or two-step process wherein the electrolytic cleaning follows the non-electrolytic cleaning.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes. See page 68.

It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patent to enhance the cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over any one U.S. Patent No. 6,280,527 and 6,277,799 in view of Spring (Metal Cleaning).

The applied references have a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

US Patents No 6,280,527 and 6,277,799 teach cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures.

The Patents do not teach electrolytic cleaning or two-step process wherein the electrolytic cleaning follows the non-electrolytic cleaning.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68. Spring also teaches that electrocleaning enhance the chemical cleaning in several ways.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes. See page 68.

It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patents to enhance the cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes.

Response to Arguments

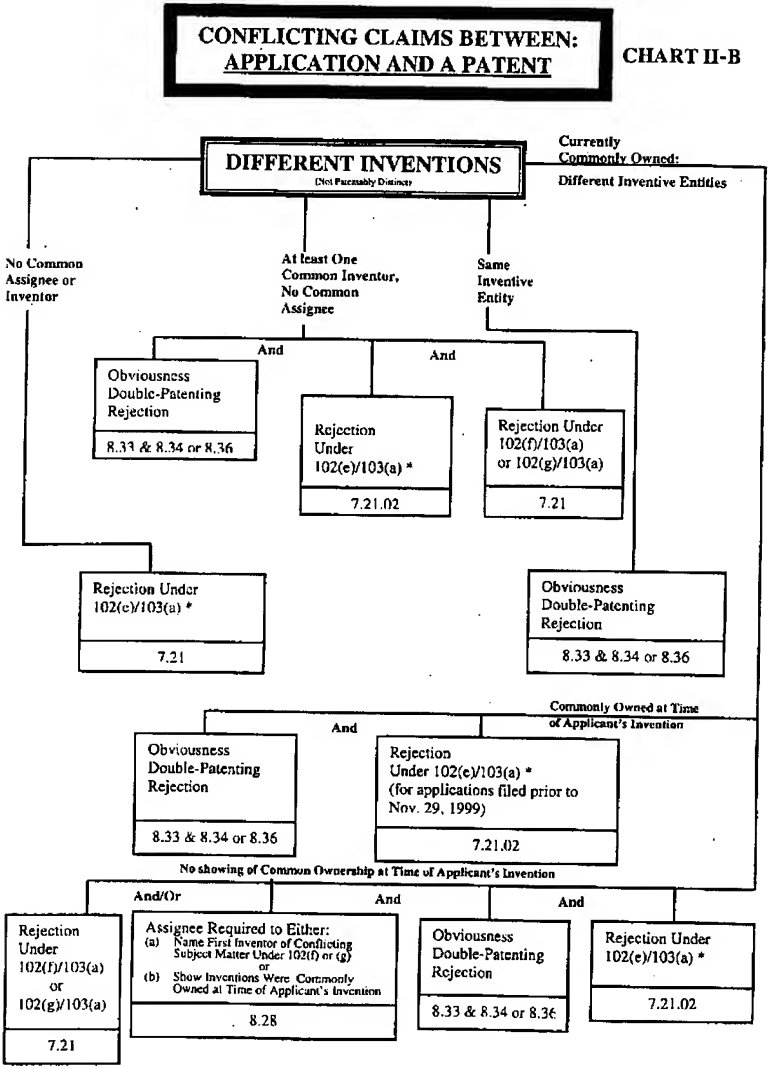
7. Applicant's arguments filed 03/05/04 have been fully considered but they are not persuasive.

With respect to the Double-Patenting rejection the applicants argue that, according to their position, the Double patenting rejection is not appropriate because the applied patent is a prior art. The applicants cite In re Braithwaite (CCPA) 154 USPQ 29 and reference to MPEP 804.

The Applicants arguments are not persuasive:

It appears that the applicants rely on page 34 of In re Braithwaite. However, neither the cited part of the case, nor other parts of the decision supports the applicant's position that the Double-Patenting rejection is not proper if the conflicting claims are from the patent, which is a prior art. While stating that the rejection under 35 USC 103 is not proper when the patent is not a prior art, the cited authority does not state that the Double-Patenting rejection is not proper when the conflicting claims are from the patent, which is a prior art. See at least page 34 and Footnote 4 on page 35.

MPEP 804 in contrast to the applicant's statement requires to make both rejections the Double-Patenting rejection and the rejection under 35 USC 103. See at least Chart II-B:



*The reference patent would NOT be prior art under 35 U.S.C. 102(e) where the patent issued from an international application and the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published.

With respect to the rejection made under 35 USC 103 the applicants argue that, according to the applicants, there is no motivation to combine the applied documents and that the examiner has not provided a motivation to combine the documents.

This is not persuasive because the motivation to combine the documents was presented in the Office action. Moreover, the motivation is based on the teaching of the prior art. See the rejections presented in the instant and the previous Office actions. The applicants did not comment on the provided reasoning.

The applicants state that the method of the invention provides unexpected results. This is not persuasive because Spring teaches that electrocleaning enhances the chemical cleaning in several ways. See pages 67-73, especially second paragraph on page 67. An ordinary artisan would have reasonably expected that electrocleaning would significantly enhance the cleaning results.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alexander Markoff
Primary Examiner
Art Unit 1746

am

ALEXANDER MARKOFF
PRIMARY EXAMINER